

## REMARKS

Claims 26 and 28-44 are pending in the instant application. Claims 32-39 were withdrawn by the election filed 03 November 2003, pursuant the Examiner's restriction requirement of 11 September 2001. Claims 28-31 and 40-41 were withdrawn by the supplemental election filed 24 October 2002, pursuant to the Examiner's second restriction requirement of 11 September 2002.

In the most recent Office Action, Claims 26 and 42-43 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,852,485 to Shimada, et al. (hereinafter, "Shimada") in view of U.S. Patent 6,181,402 to Shim, et al., (hereinafter, "Shim") and U.S. Patent 6,023,317 to Xu et al., (hereinafter, "Xu"). No action is given on Claim 44. That rejection is made final.

Applicant respectfully submits that the rejection is prematurely made final, and therefore requests that the finality be withdrawn. A proper final rejection shall state **all** grounds of rejection. *See*, 37 C.F.R. § 1.113 (emphasis added). The most recent Office Action gives no indication as to the status of Claim 44. Claim 44 was indicated to be generic in the second restriction requirement, and was included in the election filed 24 October 2002. Having no action on Claim 44, Applicant respectfully submits that the finality of the rejection is improper and premature. Withdrawal of finality and reconsideration of the application in light of the present amendment is kindly requested.

As amended above, Claim 26 recites a method of manufacturing a liquid crystal display device comprising, *inter alia*, forming a protection layer on said first substrate, and forming a color filter layer on the protection layer. These features find support generally throughout the original specification as filed, and specifically at, among other

places, p. 13, lines 7-11 and 18-20, and p. 16, lines 13-20. No new matter has been added.

These features are neither disclosed, nor suggested by the prior art of record, taken alone or in any combination. For example, with reference to Fig. 18B of Shimada, it can be seen that the interlayer separation film (29) is formed above the color filter (218), rather than between the color filter and the first substrate, as recited in Claim 26. The additional references Shim and Xu offer no teaching or suggestion ameliorate this deficiency of Shimada with respect to the claim. It has been held by the Courts that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Claim 26 is respectfully submitted as patentably distinguished over the prior art.

Moreover, Claim 26 recites disposing a common electrode and a pixel electrode in different layers through an interlayer separation film formed of transparent insulating material. As implicitly conceded in the Office Action, this feature is neither taught nor suggested by Shimada, taken alone or in any combination. The Office Action avers that it would have been obvious to an artisan of ordinary skill to modify the electrode arrangement of Shimada in the absence of any prior art teaching such a modification. It is however, well-settled precedent that a determination of obviousness requires some objective teaching or suggestion in the prior art indicating the desirability of the modification. *See, e.g., In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002); *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 56 USPQ2d 1456 (Fed. Cir. 2000). This requirement must be applied rigorously, to avoid the subtle

temptation to engage in impermissible hindsight reconstruction. *See, McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001). "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

Because the Prior art offers no teaching or suggestion to modify the reference in the manner proposed in the office Action, Applicant respectfully submits that the finding of obviousness is improper, and the rejection poorly taken. Favorable reconsideration and withdrawal is kindly solicited.

Claims 42-44 each depend from Claim 26. They are each separately patentable, but are submitted as patentable for at least the same reasons as Claim 26 from which they depend.

In light of the foregoing, Applicant respectfully submits that all claims define patentable subject matter, and kindly solicit an early indication of allowability. If the Examiner has any reservation in allowing the claims, and believes that a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully Submitted,



David J. Torrente  
Registration No. 49,099

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343

DJT:eg